REMARKS

Status of the Claims.

Claims 1-4 are pending with entry of this amendment, no claims being canceled and no claims being added herein. Claims 1 and 4 are amended herein. These amendments introduce no new matter. Support is replete throughout the specification.

35 U.S.C. §102.

Claims 1 and 3 were rejected under 35 U.S.C. §102(a) as allegedly anticipated by Johansen *et al.* (Abstract for Scientific Conference. Davos Switzerland. Published on or After July 12, 1992) (herein referred to as Johansen *et al.* 1992) in light of Johansen *et al.* (1993) *Br. J. Rheumatology* (1993) 32(11): 949-955. The Examiner uses the post filing date reference (Johansen *et al.* 1993) as evidence that the work disclosed in Johansen *et al.* 1992 utilized anti-YKL-40 antibodies.

Johansen *et al.* (1992) is available only under 35 U.S.C. §102(a). This reference, however, is Applicants' own work. The Examiner is reminded that, according to MPEP §2132.01:

> Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. 102(a).. . . Therefore, where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant.. . . . The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

In the instant case, Applicants provide herewith a Declaration in accordance with *In re Katz,* signed by Dr. Price, an inventor of the present application, establishing that the Johansen *et al.* (1992) reference describes Applicants' own work. Accordingly, this reference is unavailable under 35 U.S.C. §§102(a) or 103(a) and the rejection of claims 1 and 3 under 35 U.S.C. §102(a) should be withdrawn.

35 U.S.C. §103(a).

Claim 2 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Johansen *et al.* (1992), *supra*, in light of Johansen *et al.* (1993), *supra,* in light of Maurer *et al.* (1980) *Meth. Enzymology*, 70: 49-70. Johansen *et al.* is cited as allegedly teaching anti-YKL-40 antibodies, while Maurer *et al.* is cited as disclosing methods of making polyclonal and monoclonal antibodies to many antigens. Claim 4 was rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Johansen *et al.* (1992), *supra.*, in light of Johansen *et al.* (1993), *supra,* in view of Olsen *et al.* (WO 90/08195). Johansen *et al.* is cited as allegedly teaching anti-YKL-40 antibodies, while Olsen *et al.* is cited as disclosing labeled monoclonal antibodies and teaching that monoclonal antibodies can be labeled and used in conventional assay procedures. Applicants traverse.

The Examiner is respectfully reminded that *prima facie* case of obviousness requires that the combination of the cited art, taken with general knowledge in the field, must provide **all of the elements** of the claimed invention. When a rejection depends on a combination of prior art references, there must be some **teaching, suggestion, or motivation to combine** the references. *In re Geiger*, 815 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Moreover, to support an obviousness rejection, the cited references must additionally **provide a reasonable expectation of success**. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991), *citing In re Dow Chemical Co.,* 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

In the instant case, in view of the "Katz" declaration provided herewith, the Johansen *et al.* references are unavailable as prior art under 35 U.S.C. §§102 or 103. The remaining references are simply Maurer *et al.* and Olsen *et al.* Neither of these references offer any disclosure, teaching, or suggestion of anti-YKL-40 antibodies. The remaining cited art thus fails to provide all of the elements of the invention and offers no teaching or suggestion to provide monoclonal and/or labeled YKL-40 antibodies. Accordingly, the rejection under 35 U.S.C. §103(a) should be withdrawn.

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 267-4161.

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